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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,716	07/23/2003	Stacia Linsky	22310-RA	8128
30184 7590 12/28/2007 MYERS & KAPLAN INTELLECTUAL PROPERTY LAW, L.L.C. CUMBERLAND CENTER II 3100 CUMBERLAND BLVD , SUITE 1400 ATLANTA, GA 30339			EXAMINER HALE, GLORIA M	
			ART UNIT 3765	PAPER NUMBER
			MAIL DATE 12/28/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/625,716

**Applicant(s)**

LINSKY ET AL.

**Examiner**

Gloria Hale

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-14, 16-23 and 25-29 is/are rejected.
- 7) ☐ Claim(s) 6, 15 and 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 8 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Fingleson et al (US 5,479,661).

In regard to claim 1 Fingleson et al discloses a breast self-examination apparatus, garment 10, including a form-fitting garment (since it fits a wearer's form as broadly claimed) with at least one examination pattern 38,40 (see Fingleson col. 3, lines 35-67 and col. 4, line 10) disposed on the garment wherein the garment is a shirt( such as a sleeveless shirt) and formed from a thin material(see col. 3, lines 1-4). The Fingelson et al garment discloses a form-fitting garment as broadly claimed in addition to "armpit areas" wherein the open area under the arm in addition to the area thereabout the sides of the garment that fold under the wearer's arms when worn is the "armpit area". Applicant has not claimed the armpit areas as having fabric therein. The Fingleson apparatus comprises a low coefficient of friction since it allows the movement of the hands on the surface of the garment about the breasts with the examination pattern disposed on the garment so that it overlies a breast of the wearer as claimed in claims 3 and 4. (See Fingleson col. 3, line 35- col. 4, line 23). The material of Fingelson

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et al is of the same as claimed as applicants since the materials claimed are just general garment or shirt fabrics widely used in the marketplace. The Fingleson garment further comprises at least one alignment mark 42 centrally disposed within the examination pattern to center a wearer's nipple as claimed in claim 5 (See Fingleson col. 3, line 42). Fingleson discloses the pattern designs as claimed in claim 8 as seen in the figures. In regard to claim 28 Fingleson discloses the method of breast self-examination including obtaining the breast examination form-fitting garment 10 with the pattern thereon 38,40; putting on the garment, aligning the garment pattern with the breast and examining the breasts as claimed(see Fingleson col. 4, lines 10-23). (See Fingleson, figures 1 and 3-8). The wearer of Fingelson et al would palpitate the breast from "outside of the garment" wherein the term "outside of the garment" is considered to be away or outside of the garment material and not sliding or gliding over the garment material surface as intended. Applicant did not properly claim the step of palpitating the breast from the outer surface of the garment material as intended. The user of Fingelson would guide their finger over the breasts over at least one of the examination areas as claimed.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 7,11-14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fingleson et al in view of Morrison (US 4,873,982).

Fingleson discloses the invention substantially as claimed. However, Fingleson does not specifically disclose the garment as extending directly over the underarm area. It is well known that the breasts, especially of large breasted women, extend to the underarm or side area of a woman's body in addition to the lymph glands affected by breast cancer which are known to also extend into the underarm area. The Morrison garment is a breast examination garment that extends to an underarm or side area of the wearer and is also constructed of a material with the desired coefficient of friction for easy examination across the wearer's skin in addition to under the arms with the tube top structure of the garment. Morrison also discloses that the garment is adapted for use in other areas of the body where the detection of lumps is desired (such as the underarm area). (See Morrison, col. 4, lines 18-27). Also it is disclosed by Morrison that a doctor may mark the garment area where checking or examination is desired (See Morrison, col. 4, lines 12-17). Accordingly, it would have been obvious to one having ordinary skill in the art to construct the Fingleson garment to extend under the arm areas by including the side portions as seen in Morrison and to mark those areas in a similar fashion as the Fingleson front surface as suggested by Morrison in col. 4, lines 12-17 in order to effectively examine the wearer for breast cancer. The Fingleson and Morrison garments are shirts and have the desired coefficient of friction as claimed in claims 12 and 13. Applicant's claimed materials are well-known garment or shirt materials all of which allow easy movement across the fabric surface with one's hands

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or fingers. Fingleson also discloses the central mark 42 with the examination patterns as in claims 14 and 16. (See Morrison, col. 4, lines 18-27, 12-17).

Claims 9, 10, 19-23, 25-27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fingleson in view of Rusin (US 6,412,491).

Fingleson discloses the invention substantially as claimed. However, Fingleson does not specifically disclose the marker pens as claimed. Rusin discloses a breast examination device with a sheet material and a marker pen, col. 3, lines 32-34, not numbered in order to mark areas on the sheet 101 for further examination or areas of concern. Accordingly it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the garment of Fingleson to include a marking pen to mark areas on the garment over the sites on the wearer where further examination or areas of interest are on the wearer.

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fingleson et al in view of Morrison (US 4,873,982) and further in view of Rusin (US 6,412,491).

Fingleson et al and Morrison disclose the invention substantially as claimed. However, they do not specifically disclose the marking indicators as claimed. Rusin discloses a marking pen in col. 3, lines 32-34 that is used to mark area of interest or areas for further examination on the sheet material covering the wearer or patient. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the garment of Fingleson and Morrison to include a

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marking pen as disclosed by Rusin in order to mark areas on the garment over the sites where further examination or areas of interest are on the wearer.

Claims 6, 15 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

None of the cited references, alone or in combination, disclose the nipple aperture for nipple location on the garment as claimed in claims 6, 15 and 24.

### ***Response to Arguments***

Applicant's arguments filed 10-1-07 have been fully considered but they are not persuasive.

In regard to applicant's remarks of pages 3-8 of the 10-1-07 response it is still the Examiner's position that Fingelson discloses a form-fitting breast self examination apparatus with a pattern thereon as broadly claimed. The Fingelson garment fits the wearer's form and is therefore form fitting as broadly claimed. The term formfitting is defined as being snugly or closefitting on a wearer. The fabric of the Fingelson fgarment fits snugly or closely across the wearer's chest just as applicant's shirt in that it lies across the wearer's chest. A t-shirt, whether it is formed of a cotton or cotton and elastic material, stretches and moves when a hand is placed thereunder. In fact a t-shirt with or without elastic yarns therein would stretch more than the Fingelson garment that is made of just a woven material. The form-fitting function would depend greatly on the size of the wearer. Wherein it would fit a larger busted person closer than a smaller-

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busted person. Applicant has been instructed to remove the functional formfitting language and replace it with more decisive structural terms such as the specific materials used to form the garment in addition to a specific pattern structure that makes the garment formfitting. Fingelson is therefore just as formfitting as what has been claimed and as covers "Armpit areas" as broadly claimed since the side portions of the Fingelson et al garment, along the side edges would cover the outer edges of one's armpits at the front and rear shoulder areas. The exact underarm area, such as in an isolated point has not been claimed. Applicant's drawings also show the e armpit areas as extending outwardly from under the arms to cover a wearer's lymph gland areas. The Fingelson garment is a shirt as broadly claimed in that it is a sleeveless shirt structure. Applicant has also not defined a specific coefficient of friction of the material and utilizes the same common garment materials that would be used in Fingelson. A specific stretch spandex construction must be claimed to overcome the Fingelson reference, However, such garments are widely known in the marketplace and are worn for comfort to a wearer. Applicant is arguing more than what has been specifically claimed. If Applicant's garment is a knit or spandex structure it must be claimed as such. Also applicant has not adequately claimed the "armpit areas" as argued. The armpit areas have not been claimed as including fabric. Additionally, many elastic spandex t-shirts are on the market with imprinted matter including massage instructions. The Fingelson et al garment is a shirt as broadly claimed such as a tank shirt that includes a neck opening, front and back panels and arm openings necessary to forma shirt. The material of Fingelson is of a fabric or paper as broadly claimed since they are



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thin materials. No specific "thinness" or "thickness" have been claimed. Applicant is again arguing more than what has been claimed. Reference number 42 is an alignment point and applicant has not discussed the point 42 on page 3 of the remarks. Enlarging the Fingelson garment for larger breasts would have been an obvious modification to one having ordinary skill in the art which would include supplying a fabric/garment portion along the sides of the breasts since large breasted women have more area along the sides of their bodies. Placing the pattern to cover all areas of the breast would also be an obvious modification. Morrison includes fabric over underarm or armpit areas and placing a pattern thereon would have been an obvious modification when placing patterns in body areas where one would want to do a breast exam. The placement of the Fingelson et al examination pattern on any upper torso body garment that would be worn by a wearer would be an obvious modification. The Rusin patent was only relied upon for use of the markers as discussed in the above rejection. Claims 11-14 and 16 are not allowable for the same reasons as discussed above in regard to claims 1,2,5 and 7. The specific differences of applicant's invention have not been claimed. The specific garment structure to better describe the shirt structure with the torso encircling portion and sleeves formed of the spandex material needs to be claimed. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does

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not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The Examiner has discussed the above application with other Primary Examiners and all have come to the same conclusion. The addition of the printed matter for examination of the breasts as disclosed by Fingelson et al on other garments such as t-shirts, without or without a spandex material therein, would have been an obvious modification. A combination of design choice as to what type of garment they would want the examination pattern on in addition to common sense wherein one of ordinary skill in the art would have the common sense and ability to place it on a garment that would cover all of the body areas wherein the examination pattern needs to lie. Such as in the underarm areas where lymph glands lie and also to cover larger breasted women and to do so with a stretch knit or spandex material so that the garment is comfortable on the wearer. Examining under or over the fabric surface is a matter of choice based on one's desire to be or not be touched closely in an examination wherein any lump that is to be felt would be felt with a common garment fabric normally used in shirts. Wherein the garment would not be in lieu of one's recommended breast scan/mammogram and would not be a final determination of whether one has a lump or not. But is just another examination pattern instruction guide similar to those found on charts to be hung on door knobs. Additionally, the term "form-fitting" as broadly claimed is any

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garment that would fit on a wearer's form and does not have to include that the garment is skin-tight fitting. Therefore, the line of patentability remains as stated above.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gloria Hale whose telephone number is 571-272-4984. The examiner can normally be reached on Tues.-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Welch can be reached on 571-272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gloria Hale  
Primary Examiner  
Art Unit 3765

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